

REMARKS/ARGUMENTS

Prior to the entry of this Amendment, claims 1-5, 7, 8, 10-14, and 17-37 were pending in this application. Claim 8 has been amended, no claims have been added, and no claims have been canceled herein. Therefore, claims 1-5, 7, 8, 10-14, and 17-37 remain pending in this application. The Applicants respectfully request reconsideration of these claims for at least the following reasons.

35 U.S.C. § 112 Rejection

The Final Office Action has rejected claim 8 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. Accordingly, claim 8 has been amended to correct the informality. Specifically, claim 8 has been amended to depend upon claim 1 rather than claim 6. The applicants respectfully submit that, this amendment presents no new matter and is made only to correct an informality. Therefore, the Applicants respectfully request entry of the amendment. Further, the Applicants submit that, by this amendment, the reason for the rejection has been overcome. Therefore, the applicants respectfully request withdrawal of the rejection.

35 U.S.C. § 103 Rejections, Horikawa in view of Cautley in view of Britton

The Final Office Action has rejected claims 1-5, 8, 10-14, 18-28 and 31-37 under 35 U.S.C. § 103(a) as being unpatentable over European Patent Application No. 0,495,983 to Horikawa et al. (hereinafter "Horikawa") in view of U.S. Patent Publication No. 2002/0065697 to Cautley et al. (hereinafter "Cautley") in view of U. S. Patent No. 6,591,289 to Larry W. Britton (hereinafter "Britton"). The Applicants respectfully submit that the Office Action does

not establish a *prima facie* case of obviousness in rejecting these claims. Therefore, the Applicants request reconsideration and withdrawal of the rejection.

In order to establish a *prima facie* case of obviousness, the Office Action must establish: 1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine their teachings; 2) a reasonable expectation of success of such a modification or combination; and 3) a teaching or suggestion in the cited prior art of each claimed limitation. See MPEP §706.02(j). However, the references cited by the Office Action do not teach or suggest each claimed limitation. For example, none of the references, alone or in combination, teaches or suggests locking one or more electronic documents in response to a first signal indicating the documents are ready to file or converting electronic documents into a locked image file in response to a second signal indicating filing of the documents.

Horikawa is directed to "terminal equipment for automatically merging image data with text generating procedure documents, checking text formats, and transmitting and receiving text online." (page 3, lines 3-5) Horikawa teaches a terminal which reads text from different formats, converts it into an internal or intermediate format for editing and then converts to a transmission format. (Abstract, Fig. 1, and page 3, line 50 - page 4, line 19) However, as noted in the Office Action, Horikawa does not teach or suggest automatically locking one or more electronic documents in response to a first signal indicating the documents are ready to file. Furthermore, Horikawa does not teach or suggest converting electronic documents into a locked image file in response to a second signal indicating filing of the documents.

Cautley is directed to "an apparatus and method for project evaluation, approval and monitoring." (para 25) Under Cautley, a "proposal is electronically submitted and stored. Once submitted in a final version, the proposal is frozen by the system, so that subsequent review by any number of reviewers is conducted based on the same proposal parameters." (para 7) Reviewers can review the material and offer comments and a decision is made and entered into

the system. (para. 7) "If accepted, the proposal moves forward and becomes a project. If not, the system may unfreeze the proposal and allow revision." (para. 7) However, Cautley does not teach or suggest automatically locking one or more electronic documents in response to a first signal indicating the documents are ready to file with a patent office. Furthermore, Cautley does not teach or suggest converting electronic documents into a locked image file in response to a second signal indicating filing of the documents.

Britton is directed to "a method of delivering a formatted electronic document over a communications network, wherein the document is created upon request and immediately converted into a pre-determined file format prior to delivery." (Col. 1, lines 20-24) More specifically, the cited portion of Britton, col. 2, line 53 - col. 3, line 9, describes distributing electronic documents as a .pdf file to prevent them from being altered by the recipient. However, Britton does not teach or suggest converting electronic documents into a locked image file in response to a signal indicating filing of the documents with a patent office. Rather, Britton teaches converting formatted files to .pdf files upon the files being requested by a client. (Abstract, col. 3, line 56 - col. 4, line 8, and col. 4, lines 35-61)

The combination of Horikawa, Cautley, and Britton is no more relevant to the pending claims than any of the references alone since none of the references, alone or in combination, teach or suggest locking one or more electronic documents in response to a first signal indicating the documents are ready to file or converting electronic documents into a locked image file in response to a second signal indicating filing of the documents.

Claim 1, upon which claims 2-5, 7, 8, 10, 11, 26, 26, and 29 depend, recites in part "receiving from a user a first signal indicating that one or more of the electronic documents are ready to be filed in a patent office; automatically locking the one or more electronic documents into a non-editable form in response to the first signal; receiving from the user a second signal indicating that the documents are filed in the patent office; and in response to receiving the second signal, automatically converting the one or more electronic documents from

a first document type to a locked image file." None of the references, alone or in combination, teach or suggest locking one or more electronic documents in response to a first signal indicating the documents are ready to file or converting electronic documents into a locked image file in response to a second signal indicating filing of the documents. Rather, Horikawa teaches a terminal which reads text from different formats, converts it into an internal or intermediate format for editing and then converts to a transmission format while Cautley teaches a system that locks proposals to prevent editing during a review period and Britton teaches converting formatted files to .pdf files upon the files being requested by a client. For at least these reasons, claims 1-5, 7, 8, 10, 11, 26, 26, and 29 should be allowed.

Claim 12, upon which claims 13, 14, 17-19, 27, 28, and 30 depend, recites in part "automatically locking down the one or more electronic documents in the package when a user transmits a first signal indicating that the package has been transferred from a first phase to a second phase, wherein locking down the one or more documents prevents further editing of the one or more documents; automatically converting the one or more electronic documents from a first document type to a locked image file when a user transmits a second signal indicating that the package has been transferred from the second phase to a third phase. None of the references, alone or in combination, teach or suggest locking down one or more electronic documents when a user transmits a first signal indicating that the package has been transferred from a first phase to a second phase or automatically converting the documents from a first document type to a locked image file when a user transmits a second signal indicating that the package has been transferred from the second phase to a third phase. Rather, Horikawa teaches a terminal which reads text from different formats, converts it into an internal or intermediate format for editing and then converts to a transmission format while Cautley teaches a system that locks proposals to prevent editing during a review period and Britton teaches converting formatted files to .pdf files upon the files being requested by a client. For at least these reasons, claims 12-14, 17-19, 27, 28, and 30 should be allowed.

Claim 20, upon which claim 21-24 and 31 depend, recites in part "receiving from a user a first signal indicating that package is ready to be filed in a patent office; in response to the first signal, locking the plurality of documents in a non-editable form; receiving from the user a second signal indicating filing of the package with the patent office; in response to the second signal, automatically transforming the one or more electronic documents from its native format types into a format type that is viewable as it will be printed." None of the references, alone or in combination, teach or suggest locking one or more electronic documents in response to a first signal indicating the documents are ready to file or converting electronic documents into a locked image file in response to a second signal indicating filing of the documents. Rather, Horikawa teaches a terminal which reads text from different formats, converts it into an internal or intermediate format for editing and then converts to a transmission format while Cautley teaches a system that locks proposals to prevent editing during a review period and Britton teaches converting formatted files to .pdf files upon the files being requested by a client. For at least these reasons, claims 20-24 and 31 should be allowed.

Claim 32, upon which claim 33 depends, recites in part a system comprising instructions to "receive a first signal indicating that one or more of the electronic documents are to be filed in a patent office; automatically lock into a non-editable form the one or more electronic documents to be filed in a patent office in response to the first signal; receive a second signal indicating that the electronic documents are filed in the patent office; and in response to receiving the second signal, automatically convert the one or more electronic documents from a first document type to a locked image file." None of the references, alone or in combination, teaches or suggests locking one or more electronic documents in response to a first signal indicating the documents are ready to file or converting electronic documents into a locked image file in response to a second signal indicating filing of the documents. Rather, Horikawa teaches a terminal which reads text from different formats, converts it into an internal or intermediate format for editing and then converts to a transmission format while Cautley teaches a system that locks proposals to prevent editing during a review period and Britton teaches

converting formatted files to .pdf files upon the files being requested by a client. For at least these reasons, claims 32 and 33 should be allowed.

Claim 34 recites in part a computer readable medium comprising instructions executable to "receive a first signal indicating that one or more of the electronic documents are to be filed in a patent office; automatically lock the one or more electronic document into a non-editable form in response to the first signal; receive a second signal indicating that the electronic documents are filed in the patent office; and in response to receiving the second signal, automatically convert the one or more electronic documents from a first document type to a locked image file." None of the references, alone or in combination, teach or suggest locking one or more electronic documents in response to a first signal indicating the documents are ready to file or converting electronic documents into a locked image file in response to a second signal indicating filing of the documents. Rather, Horikawa teaches a terminal which reads text from different formats, converts it into an internal or intermediate format for editing and then converts to a transmission format while Cautley teaches a system that locks proposals to prevent editing during a review period and Britton teaches converting formatted files to .pdf files upon the files being requested by a client. For at least these reasons, claim 34 should be allowed.

Claim 35, upon which claims 36 and 37 depends, recites in part "receiving a first signal from a user indicating that the document is ready to be filed; in response to the first signal, automatically locking the document to prevent further edits to the document; receiving a second signal from the user indicating filing of the document with the patent office; in response to the second signal, converting the document from a first document type to a second document type." None of the references, alone or in combination, teach or suggest locking one or more electronic documents in response to a first signal indicating the documents are ready to file or converting electronic documents into a locked image file in response to a second signal indicating filing of the documents. Rather, Horikawa teaches a terminal which reads text from different formats, converts it into an internal or intermediate format for editing and then converts

to a transmission format while Cautley teaches a system that locks proposals to prevent editing during a review period and Britton teaches converting formatted files to .pdf files upon the files being requested by a client. For at least these reasons, claims 35-37 should be allowed.

35 U.S.C. § 103 Rejections, Horikawa in view of Cautley in view of Britton in view of Haff

The Final Office Action has rejected claims 7 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Horikawa in view of Cautley in view of Britton as applied to claims 1-5, 8, 10-14, 18-28 and 31-37 above, and further in view of U. S. Patent No. 6,219,669 to Haff et al. (hereinafter "Haff"). The applicants respectfully traverse the rejection for at least the reason that claims 7 and 17 each depend on allowable base claims as discussed above. For at least these reasons, claims 7 and 17 should be allowed.

35 U.S.C. § 103 Rejections, Horikawa in view of Cautley in view of Britton in view of Scott

The Final Office Action has rejected claims 29 and 30 under 35 U.S.C. § 103(a) as being unpatentable over Horikawa in view of Cautley in view of Britton as applied to claims 1-5, 8, 10-14, 18-28 and 31-37 above, and further in view of U. S. Patent No. 6,489,980 to Scott et al. (hereinafter "Scott"). The applicants respectfully traverse the rejection for at least the reason that claims 29 and 30 each depend on allowable base claims as discussed above. For at least these reasons, claims 29 and 30 should be allowed.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

Appl. No. 09/997,311

PATENT

Amdt. dated: December 15, 2006

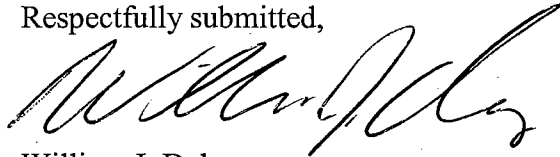
Amendment under 37 CFR 1.116 Expedited Procedure

Examining Group 2167

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

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Respectfully submitted,



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